

RECOVERY



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Supreme Court of the United States,

OCTOBER TERM 1937.

No. 396.

KELLOGG COMPANY,
Petitioner-Appellee-
Defendant,
against

NATIONAL BISCUIT COMPANY,
Respondent-Appellant-
Plaintiff.

**PETITION BY KELLOGG COMPANY, DEFENDANT
BELOW, FOR WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE
THIRD CIRCUIT.**

To the Honorable, The Supreme Court
of the United States:

The petition of Kellogg Company, defendant-appellee below, and herein referred to as defendant, respectfully shows:

STATEMENT OF THE CASE.

A. Preliminary.

This case has been heard twice by the Circuit Court of Appeals of the Third Circuit, with diametrically opposite results. The proceeding was in equity in the District Court of the United States for the District of Delaware, brought by National Biscuit Company, as plaintiff, against petitioner, the Kellogg Company, as defendant. It sought to restrain the Kellogg Company from manufacturing the ordinary, formerly patented shredded wheat biscuit illustrated in expired design patent No. 24,688 (R. V. 5, p. 62), and from using the term "shredded wheat" and the picture of the biscuit as applied thereto (Complaint, R. V. I, pp. 5-25).

District Judge Nields, after trial, dismissed the bill, because the forty-one patents originally granted to the plain-

tiff's predecessor for shredded wheat, the design patent on the form of the biscuit and the machinery and process for making it, having expired before the Kellogg Company began to sell its product, defendant was entitled to manufacture shredded wheat in the usual form and to display pictures of it in defendant's advertising. The District Court also held that because the name "shredded wheat" was a term applied by the patentee to the patent-expired product and was otherwise descriptive it was incapable of exclusive appropriation as a trademark (R. V. I, p. 225).

The District Court also found as a fact that the Kellogg Company had unmistakably distinguished its manufacture and that no deception of the public resulted from what defendant did. There was, therefore, no unfair competition. (R. V. I, pp. 204-227). The cartons in issue appear at V. I, pp. 205-219.

On appeal, the Circuit Court of Appeals affirmed the decree of the District Court in a *per curiam* opinion (R. V. III-A, p. 2069).

Thereafter the Court granted a rehearing, again heard full argument from new counsel for the plaintiff, indicated that counsel for the defendant need not argue at length, and thereupon did the unusual thing of handing down an elaborate opinion completely reversing its first opinion, granting all the prayers of plaintiff's bill of complaint and even going far beyond plaintiff's final or modified prayers.*

* On the original hearing in the Court of Appeals, the Court questioned the plaintiff's counsel concerning its power to enjoin the defendant from all competition whether fair or unfair, and plaintiff's counsel conceded that the Court had power to restrain only unfair competition; in short, defendant's right to manufacture was admitted to be indisputable. This oral concession was embodied in plaintiff's brief entitled "Appellant's Brief on Rehearing", at page 34:

"We confidently submit that the decree of the District Court, dismissing the Bill, should be reversed and the case remanded to that court, with instructions to enter a decree for the complainant: . . .

2. That the defendant be enjoined from manufacturing or selling or offering for sale Whole Wheat Biscuit in substantially the form and shape of the plaintiff's biscuit, unless each such biscuit be banded or marked in such a distinctive manner as to state clearly that it is a product of the defendant and not of the plaintiff."

Defendant accepted plaintiff's concession, and did not argue the same, stating at page 5 of its brief on rehearing:

"2. Plaintiff's belated concession of defendant's indubitable right to make the patent-expired biscuit, necessarily concedes defendant's equally indubitable right to call it by its patent-expired name."

the Court in its second decision directed the District Court to enjoin the defendant perpetually from using the words "redded wheat" as a trade name and from offering its product for sale in the form and shape of plaintiff's (R. V. -A, pp. 2083-2093). The Court did this without finding any new or different facts and without considering any authorities which had not been before it on the earlier argument.

The first decision of the Circuit Court of Appeals, like that of the District Court, was based on the doctrine of dedication of form and description to the public by patent expirations as expressed by *Singer v. June*, 163 U. S. 169. The second decision can hardly be characterized as less than an attempt to reverse the doctrine of *Singer v. June*, in a case in which the plaintiff, by threats of trademark suits, drove the defendant off the market in 1922, not to return until 1927. The Court's second decision held that because plaintiff thus had enjoyed approximately five years' exclusive occupation of the market, the case had ceased to be a patent expiration case and had become the same as though no patents had ever been granted. And yet the Court, in effect, revives the expired patents and makes them perpetual. If this ruling stands, the doctrine of dedication of name and form by patent-expiration will have ceased to exist.

The nearest attempt at a similar result that we have been able to find was by the same Court and was frustrated by this Court in *William Warner & Co. v. Eli Lilly & Co.*, 270 U. S. 526. The Court of Appeals, there, instead of restraining the undeniably unfair acts of the defendant, sought to penalize the entire public by setting up in plain a perpetual monopoly of the right to combine cocoa and quinine. This Court granted certiorari and unanimously reversed that attempt to use the law of trademarks as a means of setting up a revolutionary system of perpetual monopolies in publicly owned rights by judicial legislation.

B. Statement of the Facts.

I. The Plaintiff's Claim.

1. This suit was brought in the United States District Court for the District of Delaware on the claim of National Biscuit Company, plaintiff, that its exclusively owned trademarks consisted of (a) the shape, form or appearance of the well known and formerly patented, rectangular shredded wheat biscuit, a shape and form necessarily resulting from expired machine patents, (b) of the words "shredded wheat", applied to any cereal product and (c) of the representation or pictorial description of the biscuit, and that defendant had infringed these three trademarks (a) by making a smaller and darker biscuit than plaintiff's and packed in distinctive cartons, (b) by calling its product "Kellogg's Shredded Whole Wheat Biscuit" and (c) by illustrating its biscuit on its clearly differentiated packages.

The suit also alleged that the same three acts, (a), (b) and (c) above, constituted unfair competition. No unfairness otherwise was charged. No claim was made that defendant's product, as packed and sold by defendant, had ever been passed off as plaintiff's or was capable of being passed off (Complaint, R. V. I, pp. 5-25). All biscuits of both plaintiff and defendant are sold in cartons which are so distinctly different that no confusion or passing off is possible.

II. The facts developed at the trial as found by the trial Judge (R. V. I, p. 193).

(1) Shredded wheat biscuit is made by machine. The shreds or strings are deposited in successive layers on a belt and are then cut across to form the biscuit or loaf. During the baking operation the shreds arch up and give a truss-like rigidity to the fragile biscuit. The biscuit cannot be individually marked (R. V. I, p. 221).

(2) The patents on the so-called Perky machine used by the plaintiff and its predecessor to make the shape and

form of biscuit in issue, expired years ago (R. V. I, pp. 196 and 223).

(3) Plaintiff's predecessor for many years prior and up to the year 1915 printed on all the cartons of its packaged shredded wheat the following notice:

"Patented, September 17, 1895, October 15, 1895. This Food, the Process of Making It, The Special Machinery for Its Manufacture, are Under the Protection of The United States Government by virtue of Many Patents As Follows" (Listing 41 patents) (R. V. I, pp. 195-6).

Included among the patents listed under this notice was plaintiff's patent, No. 24,688, on the design or form of the biscuit which had been declared invalid in *Natural Food Company v. Hénry P. Bulkley, et al.*, No. 28,530, N. Dist. of Illinois, East Div., because Perky swore falsely that the design had not been in public use or on sale for more than two years before his application for patent (R. V. I, p. 197).

Plaintiff's basic patents expired in 1912 and all of its patents had expired before defendant entered the field (R. V. I, p. 223).

(4) The machine of the expired patents produces the very form and shape of biscuit in dispute (See V. 5, pp. 12-13, Perky patent No. 532,286 and V. 5, pp. 110-119, Perky patent No. 678,127). A perpetual monopoly in the form and shape of the biscuit would unavoidably give plaintiff a similar monopoly in the machine of the expired patents in spite of the expiration of the patents, for the necessary result of the use of the machine is to produce the particular form and shape of biscuit in controversy. The shape of the biscuit is functional and the function of the machine is to produce that shape of biscuit.

(5) Defendant's proofs established that it had tried to mark or band the biscuit but that it was not practical to do so (R. V. I, p. 221). Plaintiff in effect, confessed this to be true by offering no proof of any way of marking the biscuit and by contending that defendant should

make some other shape of biscuit (R. V. 3, p. 2019, and V. I, p. 270). Defendant's proofs showed that the only known way visually to distinguish its biscuit was to make them shorter and darker than plaintiff's and enclose them in distinctive cartons. This defendant has always done (R. V. I, p. 221). As a matter of fact after defendant had marketed its small biscuit for five years, plaintiff copied the defendant's size exactly thus wiping out the size distinction which defendant had adopted (R. V. I, p. 264).

(6) The language which plaintiff claims to have exclusive right to use, that is, the words "shredded wheat", is the very language used in the specification of the Perky patents under which plaintiff's predecessor had a monopoly for seventeen years, to describe the product and process of making it. Thus

Perky patent No. 520,496, May 29, 1894:

"the resulting product * * * in the form of films, strings; or shreds are deposited * * *"

"these shreds * * fall upon this roll * * * (R. V. 5, p. 10).

Perky patent No. 532,286, January 8, 1895 (R. V. 5, p. 13):

"* * * a food preparing machine to receive the shredded or thread-like product in layers."

Perky patent No. 532,697, January 15, 1895 (R. V. 5, p. 27):

"the threads or shreds of the food product * * *"

"the material to be shredded * * *"

"to receive the shredded or filamentous discharge * * *"

Perky patent No. 533,555, February 5, 1895 (R. V. 5, p. 53):

"one of the shredders in section * * *"

"Each reducer or shredding device * * *"

"adherence of the shredded or treated product * * *"

Perky patent No. 681,656, August 27, 1901 (R. V. 5, p. 141):

"machines for cutting shredded wheat * * *"

Perky patent No. 713,795, November 18, 1902 (R. V. 5, p. 171) :

"a cracker of filamentous or shredded wheat or other grain"

Many additional quotations from plaintiff's patents, cartons and advertisements showing the use of the words "shredded wheat" by plaintiff in a solely descriptive way appear in Appendix A, p. 27.

(7) Plaintiff's cartons (V. 1, p. 205) have always prominently displayed various registered trademarks, no infringement of which is claimed in the present litigation. Its complaint does not allege any similarity. Plaintiff's main brief on appeal stated, p. 62, that "The present case is not a patent case nor a carton case", meaning that no carton similarity was charged. The Trial Court held that defendant's cartons could not be mistaken for or passed off as Plaintiff's. Plaintiff's trademark prominently carried on its cartons from 1894 until 1915, was a representation of the mythological Goddess "Ceres", holding a sheaf of wheat in her arms. This trademark was registered May 22, 1906, No. 52,858 (V. 4, p. 193). About 1915, the "Ceres" mark was supplanted by a picture of the Niagara Falls, which is still prominently displayed on plaintiff's cartons (V. 1, p. 209). In 1905, plaintiff made its first claim to the words "shredded whole wheat" as a trademark and sought to register these words, first as a fanciful mark, and later as a descriptive term. The application was rejected and the rejection upheld on appeal. *Natural Food Co. v. Williams*, 30 App. D. C. 348. On November 5, 1912, plaintiff registered as its trademark the pictorial representation of its Niagara Falls factory (V. 1, p. 205), and this trademark has since constituted the most prominent feature of its cartons. This registration No. 89,071 (V. 4, p. 199), states that the factory picture trademark is used for "shredded wheat in Class No. 46, foods and ingredients of foods". Plaintiff's registration states that "No claim is made herein to the words 'The Home of Shredded Wheat'". Plaintiff's predecessor also secured trademark registration No. 85,186 (V. 4, p.

197), on an alleged trademark showing a shredded wheat biscuit in a dish with a spoon and cream. The registration states "no claim being made to the representation of a shredded wheat biscuit," thus applying the precise description to the precise illustration and, in effect, disclaiming both.

Plaintiff's predecessor in 1926 procured registration No. 216,593 (V. 4, p. 205) for a trademark shown in the drawing as a dish containing two shredded wheat biscuits. The illustration of the two shredded biscuits is clear and undisputable. The registration states that Plaintiff "disclaims any exclusive right to the representation of the two biscuits apart from the mark shown."

Plaintiff on January 15, 1924 and again on May 25, 1926, registered the words "shredded wheat" under the Act of March 19, 1920 (V. IV, pp. 201 and 3). These registrations are statutory admissions that the words are descriptive, as the Act was enacted to permit registration of descriptive terms. These registrations are without presumption of validity.

Charles Broadway Rouss v. Winchester, (C. C. A. 2) 300 Fed. 706-712;

Sleight Metallic Ink Co. v. Marks, 52 Fed. (2) 664.

Thus plaintiff twice registered other things as its trademark and in each registration illustrated a shredded wheat biscuit, described it as a shredded wheat biscuit and disclaimed it as a trademark.

Plaintiff also disclaimed the words "shredded wheat" specifically and by descriptive usage.

Although this trademark-disclaimer-defense of the words and the design was clearly a bar to the injunction ordered, as to both form and description of the biscuit, as repeatedly held by this Court, the Circuit Court of Appeals denied rehearing without having stated its position on the question of the disclaimer on either hearing, although the defense was pressed on both hearings.

8. In 1915, Ross Biscuit Company began to make and sell a biscuit identical in size and color with plaintiff's and its right to do so was upheld by the Circuit Court of Appeals

for the 2nd Circuit in 1918. *Shredded Wheat Co. v. Humphrey Cornell*, 250 Fed. 960. Thereafter, the resources of the Ross Company became exhausted and it retired from the field. (R. V. I, p. 202).

9. Plaintiff's Canadian subsidiary, after this suit was filed, sued defendant's Canadian subsidiary in the Supreme Court of Ontario on the same cause of action here involved. After trial, that suit was dismissed on the ground of the patent expirations. *Canadian Shredded Wheat Co. v. Kellogg Co. of Canada, Ltd.*, 1936 Ontario Rep. 281. The five judges of the Court of Appeals of Ontario unanimously upheld that judgment. *Same v. Same*, 1936 Ont. Rep. 613.

10. Plaintiff's predecessor first warned defendant's predecessor in January 1922 not to make the patent-expired biscuit. The notice did not charge unfair acts but warned against any competition whether fair or not (R. V. I, pp. 103-08). Defendant retired from the market in 1922 and reentered in 1927. Suit was instituted in 1928 admittedly in part for advertising purposes, news releases being planted with newspapers days before the bill was filed (R. V. I, pp. 604-605).

In 1930 that suit was withdrawn without prejudice and this suit started two years later and tried, defendant believes, because, weary of ten years of harassment, defendant sued plaintiff for violation of the Sherman Anti-trust Act. *Kellogg Co. v. National Biscuit Co.*, 71 Fed. (2) 662.

11. After trial, the District Court dismissed the bill on the ground that the patent-expirations precluded any relief as to form, name or picture under the doctrine of *Singer v. June*, (supra); that the words "shredded wheat" were descriptive of the patent-expired biscuit, and had always been so used by plaintiff; that the shape of the biscuit was functional and not merely ornamental or fanciful; that relief could be based only on wrongful acts of defendant in passing its goods off as plaintiff's and that there had been no passing off; that defendant's packages were incapable of being passed off as plaintiff's; that defendant's biscuits outside of the package were distinguished in size and color from plaintiff's as far as was possible;

that further distinction of defendant's biscuit from plaintiff's other than by size and distinctive carton was impossible without destruction of defendant's undeniable right to compete; that plaintiff had failed to prove either its ownership of the three exclusive and perpetual monopolies it claimed as trademarks or any acts of unfair competition by defendant. (The opinion of the District Court is unreported and appears at R. V. I, p. 193. The findings are included in the opinion.)

IV. Plaintiff's appeal to the Circuit Court of Appeals for the Third Circuit was argued by Mr. Drury W. Cooper and ex-Judge Thomas G. Haight December 3, 1935 and the findings of fact and conclusions of law of the District Court and its decree dismissing the bill were unanimously affirmed in a *per curiam* opinion on January 16, 1936.

(The *per curiam* opinion of the Circuit Court of Appeals, composed of Circuit Judges Buffington, Davis and Thompson, is unreported and appears in R. V. III-A, p. 2069).

V. Plaintiff thereupon, on February 15, 1936, petitioned for rehearing on the ground principally that its alleged exclusive occupation of the market, from 1922 to 1937, after its patents had expired in 1912, had created exclusive and perpetual monopolies of form and of verbal and pictorial description of the biscuit, all by analogy to the ten year clause of the Trademark Act of February 20, 1905 (U. S. C. Tit. 15 Sec. 85). Plaintiff's counsel on the rehearing petition were those previously appearing in the cause. (R. V. III-A, p. 2079).

VI. The petition for rehearing was granted on May 7, 1936, and the reargument took place on October 8, 1936 (R. V. III-A, p. 2082). Hon. David A. Reed first appeared on plaintiff's brief on rehearing and, along with Judge Haight, argued the cause for plaintiff on rehearing, relying on the same authorities and facts as cited by Mr. Cooper and Judge Haight on the first hearing.

VII. On April 12, 1937, the Circuit Court of Appeals, filed its second opinion by Davis, C. J., reversing its former

opinion but not disturbing the findings of fact of the District Court except as to the conclusion that the words "shredded wheat", were descriptive, saying, strangely enough, that if the words "shredded wheat" were descriptive they "*could not have been the subject of a patent*". (R. V. III-A, p. 2086 but see, Appendix A, pp. 27-28). The Court ordered the District Court perpetually to enjoin defendant from marketing the patent-expired biscuit, from pictorially describing it by illustration on its package, or from marketing any product under the words "shredded wheat". The second decision of the Circuit Court of Appeals revived the expired design, product, process and machinery patents as applied to shredded wheat biscuit and made them perpetual. The second opinion of the Court on rehearing is not yet reported and appears at R. V. III-A, p. 2083.

VIII. Defendant thereupon filed a petition for rehearing on May 7, 1937, and thereafter filed motions (R. V. III-A 2130 and 2145) for an injunction and for recall of the second decision on the ground that plaintiff had widely, unfairly and falsely advertized that defendant was under injunction and had otherwise unfairly exploited the Court's second opinion by publishing unfair excerpts therefrom, especially as to the phrase "The original bears this signature W. K. Kellogg" which had never been an issue in the case, was not mentioned in the complaint and is not covered by the prayers for relief or by the injunction ordered and which was off of nearly all of defendant's cartons at the time of the trial (R. V. III-A, p. 2131).

IX. The Court on July 13, 1937 denied defendant's petition for a rehearing without opinion (R. V. III-A, p. 2240), and on the same day denied its motions concerning respondent's untrue statement that defendant was under injunction and other unfair use of the decision (R. V. III-A, 2241). This denial was also without comment or condemnation of the unfair exploitation by plaintiff of a decision, with no mandate issued, with a petition for rehearing pending and other avenues of review unexplored.

The mandate below is still stayed pending this petition.

III. Reasons for Granting the Writ.

A. Preliminary.

The questions presented are whether the case involves serious and important constitutional questions and conflicts of decision involving the same or similar subject matter as between the first decision of the Circuit Court of Appeals and the last one and also as between that decision and the decisions of this Court concerning the effects of patent expirations on names and forms of patented products and machines; also as to the effect of trademark disclaimers; and as to the well established rule that perpetual monopolies of manufacture of either unpatented or patent-expired products shall not be set up under the guise of trademarks, and that patents, or monopolies, may be granted or extended only by Congress and not by the Courts and only for limited terms.

Also whether there is conflict between the last decision of the Court and the decisions of the Supreme Court and Court of Appeals of Ontario on the same subject matter and involving the same rules of law as to patent-expiration. Also as to whether there is conflict between the Second and Third Circuits, where on substantially the same facts one Court holds that defendant has a cause of action against plaintiff and the other Court holds that plaintiff has a cause of action against defendant.

Also whether there is conflict between the last decision below holding that the words shredded wheat were a true trademark and the decision of the Circuit Court of Appeals of the District of Columbia which held the exact opposite.

Also whether there is conflict between the Circuit Court of Appeals for the Second Circuit which held that the right of the Ross Biscuit Company to make and sell the patent-expired biscuit in issue was indubitable and the last decision in the Third Circuit which enjoins defendant from selling the biscuit in issue and thus, in effect, from making it.

B. Specific Reasons for Granting the Writ.

1. The last decision of the Circuit Court of Appeals of the Third Circuit holding that plaintiff may lawfully appropriate exclusively the form of (and thus the right to manufacture) the biscuit in issue is in direct conflict with the decision of the Circuit Court of Appeals for the Second Circuit in *Shredded Wheat Co. v. Humphrey Cornell, supra*, in which an opposite conclusion was reached. In that case, plaintiff's predecessor, The Shredded Wheat Company, sued the Humphrey Cornell Company, distributor for Ross Biscuit Company, in the District Court in Connecticut for alleged trademark infringement and unfair competition, alleged to consist of making and selling shredded wheat biscuit of the same size and shape as plaintiff's, in cartons which were incapable of being confused with plaintiff's cartons of shredded wheat biscuit. The District Court after the trial enjoined the defendant from marketing any biscuit in cartons or apart from cartons unless each biscuit was individually impressed, tagged or marked to distinguish it from plaintiff's unmarked biscuit. This corresponded to plaintiff's final prayer in the instant case. Footnote, *ante*, p. 2.

On appeal, the Circuit Court of Appeals for the Second Circuit modified the District Court's decree by holding (1) that as to biscuit that reached the final consumer in defendant's cartons, there should be no injunction, (2) that as to biscuit served apart from the carton (restaurant service), the defendant should endeavor for a period of six months to tag or impress a mark upon such biscuit and (3) that if after the six month's trial, the defendant should be unable to mark its biscuit without destruction of its right to compete, it might apply to the Court to vacate the injunction ordered. Judge Ward dissented, holding that the bill should be dismissed; that the form was functional and that the fragile biscuit could not be marked.

Even Judge Thomas in the District Court in the Humphrey Cornell case did not go so far as to enjoin

the defendant from making the biscuit at all and in perpetuity, and Ward, C. J., as aforesaid, dissented from the tentative and limited injunction ordered by the compromise reached by Judges Learned Hand and Hough of the Court of Appeals of the Second Circuit.

2. The last decision of the Circuit Court of Appeals of the Third Circuit holding that the words shredded wheat are not descriptive of the goods, were not so used by plaintiff and are capable of exclusive appropriation by plaintiff is in substantial conflict with the decision of the Court of Appeals of the District of Columbia in *Natural Food Company v. Williams, supra*, in which a contrary conclusion was reached on substantially the same issues and in which plaintiff acquiesced by the disclaimers aforesaid. *Ante*, p. 7.

In that case it appeared that the words shredded wheat were used originally by plaintiff's predecessor, Natural Food Company, descriptively and without claim of trademark, but after the enactment of the Trademark Act of February 20, 1905 (U. S. C. Title 15 Sec. 85) with a provision permitting registration of descriptive words used exclusively for at least ten years next preceding passage of the act, plaintiff's predecessor first associated a trademark notice with the words shredded wheat and filed an application to register them. After rejection as a fanciful name, plaintiff vainly sought registration as a descriptive mark used exclusively for ten years prior to 1905. Opposition was filed by William E. Williams on the ground of concurrent user and descriptiveness. The opposition was sustained by the tribunals of the Patent Office and by the Court of Appeals of the District of Columbia.

The Circuit Court of Appeals held that plaintiff's predecessor had not for ten years prior to 1905 exclusively used the words "shredded whole wheat" and that in fact it was open to question whether the words had ever been claimed or used as a trademark prior to the enactment of the ten year clause in 1905. It was also held that the words were clearly and solely descriptive of the product of many

shredded wheat patented machines and used in the patents as a description. *Natural Food Co. v. Williams, supra.*

3. The last decision of the Circuit Court of Appeals of the Third Circuit is in substantial conflict with the decision of the Second Circuit in *Kellogg Company v. National Biscuit Company, supra.*

In that case defendant in or about 1932 sued plaintiff for damages for alleged violation of the Sherman Anti-Trust Act, reciting facts which it claimed established a conspiracy to monopolize the manufacture of the patent-expired shredded wheat. The complaint in that action contains the affirmative allegations made in the answer filed by defendant in the instant litigation. District Judge Caffey, on motion, dismissed the complaint. On appeal the Circuit Court of Appeals for the Second Circuit reversed and held that the complaint set forth a cause of action for violation of the Sherman Act. Therefore, on substantially the same state of facts, the Circuit Court of Appeals of the Second Circuit holds for defendant and the Third Circuit holds for plaintiff. Conflict could hardly be more pronounced.

4. The last decision of the Circuit Court of Appeals of the Third Circuit is in substantial conflict with the decision of the highest court of Ontario on the identical issues in *Canadian Shredded Wheat Company, Ltd. v. Kellogg Company of Canada, Ltd., supra.* In that case brought after starting the instant suit, plaintiff's Canadian subsidiary sued defendant's Canadian subsidiary on the same cause of action in the Supreme Court of Ontario. Mr. Justice McTague dismissed the complaint, *Canadian Shredded Wheat Company, Ltd. v. Kellogg Company of Canada, Ltd., supra*, holding that plaintiff had no trademark rights in the form and verbal and pictorial description of the patent-expired biscuit.

On appeal, the five judges of the Court of Appeals of Ontario unanimously affirmed the judgment of Mr. Justice McTague. The case is now pending in the Privy Council.

The Canadian law as applied in that case is the same as the American, English and French law. Defendant's business north of the Canadian line is now held to be lawful while south it is unlawful. This is a serious and important conflict in every way. Surely defendant should be free to compete with plaintiff in a fair way in the United States as in Canada.

5. The last decision of the Court below is also, we believe, in conflict with the decision of this Court in *Singer v. June, supra*, regarding the effect of patent expirations upon the form and name of a patented article.

In that case it was held that after the Singer patents had expired the product covered by them and the name applied thereto could not be restricted to the sole use of the patentee. Yet in the present case the Circuit Court of Appeals for the Third Circuit has wholly disregarded this doctrine and granted a perpetual monopoly.

The Singer-June rule of irrevocable dedication of name and form by patent expiration is elementary, sound and established law and should not, we submit, be overruled, repealed or disregarded as the Court below does in its second decision.

6. The last decision of the Court below is also in conflict with the Constitution of the United States (Art. I, Sect. 8, par. 8). The Court and Congress both lack power to revive patents or to grant perpetual monopolies in the form and in the pictorial and verbal description of a product after the expiration of patents on the design or form and on the product itself, as well as the method of and machinery for its manufacture. The Court's action in reviving and perpetuating plaintiff's patent monopolies after their expiration is a virtual breach of the constitutional limitation on the powers of Congress. The Constitution, Art. I, Sec. 8, sub-par. 8, grants power to Congress to extend monopolistic privileges to inventors and authors only and for a limited time. Under this authorization Congress has seen fit to grant to inventors

in return for their public dedication of their invention monopolies for 17 years only.

7. The injunction ordered is also in conflict with the Sherman Anti-Trust Act, approved July 2, 1890, as amended. That Act makes fair competition mandatory. Here the Court below enjoins defendant from all competition, fair or otherwise.

8. The last decision of the Court below is also in substantial conflict with its own view of the law of patent-expiration as applied in *Amiesite v. Interstate Amiesite Co.*, 72 F. (2d) 946, and also with the decision of the Circuit Court of Appeals for the Second Circuit in *Du Pont Cellophane v. Waxed Products*, 85 Fed. (2) 75; Certiorari denied, 57 Sup. Ct. 194.

9. The last decision of the Court below is contrary to *Delaware & Hudson Canal Co. v. Clark*, 13 Wall, 311, *Standard Paint Co. v. Trinidad Asphalt Manufacturing Co.*, 220 U. S. 446,* and *Warner v. Eli Lilly*, (supra), which hold the invariable rule to be, that relief in trademark infringement and unfair competition cases alike rests upon the wrongs of the defendant in passing off its goods as plaintiff's and not upon any alleged right of a plaintiff to be protected in a name or form which under the guise of a trademark will set up monopolies in products which all are free fairly to make and sell. Here the finding is that defendant's goods have never been passed off as plaintiff's and are so distinctly marked as to be incapable of being passed off (R. V. I, 204-226, V. III-A, 2072).

10. The last decision of the Court below is also in conflict with that of this Court in *Warner v. Eli Lilly*, supra, and of the Second Circuit in *Shredded Wheat Co. v. Humphrey Cornell*, supra, and other cases, holding that a Court has power only to restrain the deceptive use of ornamental,

* Judge Davis, in the second decision below, cites this case in the Circuit Court of Appeals (163 Fed. 977). Why he does so we do not know unless he is relying on the dissenting opinion of Judge Sanborn. The majority opinion of that Court, however, overruling the dissenting opinion of Judge Sanborn, was unanimously affirmed by this Court in 220 U. S. 446.

fanciful or non-essential features of dress or appearance and not, by enjoining the use of functional or mechanical shapes, forms or essential features and descriptive names, to stop the defendant from all competition however honorable and fair.

11. The last decision below is in conflict with *Warner v. Eli Lilly*, (*supra*), in another respect also. The Court below, in that case, attempted by injunction to go beyond the unfair acts of the defendant and to set up a perpetual monopoly of the right to combine cocoa and quinine there involved. This Court reversed that decision and the Circuit Court of Appeals, in effect, has now apparently disregarded the admonition of this Court by setting up similar perpetual monopolies of form and shape and of pictorial and verbal descriptions of a patent-expired product.*

12. The last decision below is also in conflict with *Centaur v. Heinsfurter*, (C. C. A. 8) 84 Fed. 955, in which Mr. Justice Brewer held that dedication of name and form by patent-expiration under the Singer-June doctrine was perpetual and not revocable even in a case of ten years exclusive occupation of the market by the patentees after the patent had expired. The Third Circuit now holds that five years occupation of the market (accomplished by threats) revives the long dead patents and makes them perpetual.

13. The last decision below also conflicts with *Kellogg Toasted Corn Flake Co. v. Quaker Oats Co.*, (C. C. A. 6) 235 Fed. 657. The Court there held that even if secondary meaning for the words "Toasted Corn Flakes" pointed to this plaintiff's predecessor as maker, the Quaker Oats Company could still make the same patent-expired product and market it as "Quaker Toasted Corn Flakes" in distinc-

* It is irrelevant to argue that "shredded wheat" is not descriptive, for the picture indisputably is descriptive and that is enjoined too. In our brief (p. 35), we give instances of the use of shredded wheat in a purely descriptive way in plaintiff's patents and advertisements.

tive and fair cartons. Different "makes" of corn flakes are just as indistinguishable, when served apart from their cartons, as are shredded wheat biscuit.

14. The last decision below is also squarely in conflict with the decision of this Court in *Beckwith v. Commissioner of Patents*, 252 U. S. 538, and *Rahtjen's v. Hotzapfel's*, 183 U. S. 1, holding that disclaimers embodied in trademark certificates are irrevocable.

This point was wholly disregarded by the Court although always pressed by defendant.

15. When the second decision came down, plaintiff, with all the driving force of its great advertising, publicity and sales promotion departments, sent all over the country advertisements, circulars, and news releases, with double check follow ups (R. V. III-A, p. 2130), stating that defendant was under injunction and excerpting only the statements of the second decision regarding the phrase "The original bears this signature W. K. Kellogg". That phrase was never an issue on the trial. The complaint makes no mention of it and there is no prayer for relief. The injunction ordered does not mention it. The phrase originated on defendant's corn flake cartons and was almost out of use at the time of the trial and had not been in use for several years prior to the second decision. Motions were made (R. V. III-A, p. 2130) to recall and to restrain the unfair use of the Court's decision. The Court denied the motion, thus putting its seal of approval on this inequitable proceeding. That action was in conflict with:

Peters v. McDonald, (C. C. A. 2nd) 61 Fed. (2nd) 1031;

Art Metal Works v. Abraham and Straus, 62 Fed. (2nd) 79.

16. Finally, we complain because we believe the Court below was unfair and denied due process because at both

hearings defendant's counsel were denied an opportunity fully to argue the case. This was particularly true with respect to the secondary defense of disclaimer and to defendant's conceded right to make and sell the biscuit in issue. After the Circuit Court of Appeals had granted its far reaching injunction on the second hearing, it refused defendant an opportunity to reargue the case. This, we believe, was unfair in view of the fact that the injunction granted went far beyond plaintiff's final prayers. *Ante*, p. 2, footnote.

We respectfully petition the Court to grant a writ of certiorari.

Respectfully submitted,

W. H. CRICHTON CLARKE,
EDWARD S. ROGERS,
ROBERT T. McCACKEN,
Counsel for Defendant-Petitioner.

BRIEF IN SUPPORT OF PETITION.

1. Opinions Below.

The opinion of the District Court of the United States for the District of Delaware, filed January 11, 1935, is printed at Record V. I, p. 193, and is not officially reported.

The first opinion of the Circuit Court of Appeals for the Third Circuit, filed January 16, 1936, is printed at Record, V. III-A, p. 2069, and is not yet reported.

The second opinion of the Circuit Court of Appeals for the Third Circuit, sur rehearing, filed April 12, 1937, is printed at Record V. III-A, p. 2083, and is not yet reported.

2. Jurisdiction.

The original decision of the Circuit Court of Appeals for the Third Circuit was rendered January 16, 1936. Plaintiff respondent duly filed a petition for rehearing which was granted, and the second decision of the Circuit Court of Appeals, sur reargument, was rendered April 12, 1937. Defendant appellee thereafter duly presented its petition for rehearing, and its motion to recall the decision, and, after argument on the latter, both the petition to rehear and the motion to recall were denied July 13, 1937 (R. V. III-A, pp. 2240-2241).

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by Act of Congress of February 13, 1925, Chapter 229, 43 Stat. 936.

3. Statement of the Case.

See petition, supra, pp. 4-11.

4. Specification of Errors Relied Upon.

The Circuit Court of Appeals, in its second decision, erred;

1. In holding that since the expiration of plaintiff's patents on shredded wheat, defendant was not entitled to

advertise or sell shredded wheat biscuits in a form and shape similar to plaintiff's, although that is the only form and shape in which said biscuits can be manufactured by the formerly patented machinery without modification.

2. In holding that plaintiff could appropriate, as trademarks, descriptive words, forms and pictures which it had specifically disclaimed as trademarks for the purpose of registering other things as its trademarks.

3. In holding that, since the expiration of plaintiff's patents on shredded wheat, defendant is not entitled to display in its advertisements pictures of shredded wheat biscuits in form and shape similar to plaintiff's, although that is the only form and shape in which said biscuits can be manufactured by the formerly patented machinery.

4. In holding, in effect, that in spite of the expiration of plaintiff's patents on shredded wheat, defendant is not entitled to use the formerly patented machinery for the purpose of manufacturing the sole product of such machinery, shredded wheat biscuits.

5. In substantially granting plaintiff a perpetual monopoly in the formerly patented machines in violation of the limitation contained in Art. 1, Sec. 8, sub-par. 8 of the Constitution which provides for the granting of such monopolies to new inventors only and for a limited time only and by Congress only, and grants no power even to Congress to revive long dead patents.

6. In holding that, since the expiration of plaintiff's patents on shredded wheat, defendant is not entitled to use the words shredded wheat to describe its product, although that is the precise language used in plaintiff's trademark registrations and patents to describe the product.

7. In holding that the words shredded wheat are not purely descriptive and that they are therefore capable of exclusive appropriation as a trademark, even after specific statutory disclaimer.

8. In holding that the words shredded wheat have acquired a secondary meaning in the minds of the public, and in further holding that they have thus become the exclusive property of the plaintiff and incapable of distinguishing and fair use by defendant.

9. In holding that the words shredded wheat, after dedication to the public by the expiration of patents pertaining thereto, and after specific statutory trademark disclaimers, may be reappropriated exclusively by plaintiff through continued user (principally because defendant was prevented by threats of litigation from competition from 1922 to 1927).

10. In holding that the words shredded wheat were capable of exclusive appropriation by plaintiff through continued user for a period of years, even in the absence of patent-dedication and trademark disclaimer.

11. In holding that defendant, who had distinguished its shredded wheat biscuits from plaintiff's in so far as possible in shape and form, and who had packed said biscuits in distinctive cartons, and who had never imitated plaintiff's carton trademarks, was guilty of trademark infringement or unfair competition.

12. In holding that the words "the original has this signature: W. K. Kellogg", a statement formerly placed on some of defendant's packages, was evidence of an intention to deceive the public and of unfair competition, especially where such phrase had never been an issue in the case, was not mentioned in the complaint or prayers for relief, and was not covered by the injunction ordered.

ARGUMENT.

By its second decision the Court below ordered the District Court to enjoin defendant perpetually

- (a) from the use of shredded wheat as a trademark.
- (b) from advertising or offering for sale its product in the form and shape of plaintiff's biscuit in violation of its trademark.
- (c) and also ordered an accounting for damages and profits.

Injunction clause (b) does not mention making and does not mention size or color.

Defendant can make the patent expired product but it is enjoined from "advertising or offering it for sale."

As to size, the plaintiff duplicated defendant's small sized biscuit five years after defendant had put it on the market and the court below has now enjoined defendant perpetually from advertising or selling any sized biscuit large or small, whether banded, tagged, packaged or not.

Moreover, plaintiff has recently sued the Ralston Purina Company in the United States District Court for the Eastern District of Missouri (*National Biscuit Co. v. Ralston Purina Company*, in Equity No. 11817) for making a thumb-nail size of shredded wheat marketed as "Shredded Ralston".

In short, plaintiff has now received a perpetual monopoly against anyone ever calling or picturing any product of any size as shredded wheat or using any kind of machinery now known or formerly patented or hereafter devised for making any size of product that resembles "the form and shape" of plaintiff's biscuit. All this in perpetuity.

Plaintiff never had anything like that kind of protection even during the life of its forty-one patents.

Petitioner respectfully submits that the second decision of the Circuit Court of Appeals is not only in conflict with the applicable decisions of this Court on important questions of law relating to patent-expirations, disclaimers, trademarks and unfair competition and with recent decisions of other Circuit Courts of Appeals involving substan-

tially the same questions of law (*Kellogg Company v. National Biscuit Company, supra*), but is also in direct conflict with Art. 1, Sec. 8, sub-par. 8 of the Constitution which grants power to Congress to extend monopolistic privileges to inventors only and to such for a limited time only. Not even Congress is given power to revive long-dead patents and to make them perpetual. The second decision is also in conflict with decisions of other Courts in cases involving the specific trade-mark and product involved in this case.

Petitioner maintains specifically that the second decision of the Court below granting perpetual monopolies in the name, shape and form of a patent-expired article is directly in conflict with the decision of this Court in *Singer v. June (supra)*, of the Circuit Court of Appeals of the Second Circuit in *Dupont Cellophane Co. v. Waxed Products Co. (supra)*, and of the Circuit Court of Appeals of the Third Circuit in a decision just preceding the one here sought to be reviewed—*Amiesite Asphalt Co. of America v. Interstate Amiesite Co. (supra)*.

The decision is directly in conflict with decisions of another Circuit Court of Appeals bearing upon the specific name shredded wheat in that it grants a perpetual trademark in this name by injunction, although the registration of such trademark under the Act of 1905 has been judicially denied.

The Natural Food Company v. Williams (supra);

See also

McKesson & Robbins v. Phillips Chemical Co., 53 Fed. (2nd) 1011.*

Plaintiff having in its patents, advertisements and trademark applications described the product itself as "shredded wheat" and specifically disclaimed exclusive right to the words "shredded wheat" and to the representation of "a shredded wheat biscuit", its claim to the exclusive use of these words and representation is barred by such descrip-

* The *McKesson-Robbins* case, 23 Fed. (2d) 763, cited by the Court below (V. IIIA at p. 2091), was reviewed in a bill under Section 4915 of the revised statutes brought by the defeated party. The Circuit Court of Appeals for the Second Circuit (53 Fed. (2d) 342; 53 Fed. (2d) 1011) vacated the decree of the Court of Appeals of the District of Columbia and cancelled the registered marks involved.

tion and disclaimers and the decision granting such exclusive use is in conflict with applicable decisions of this Court.

Beckwith v. Commissioner of Patents, (supra); Holzapfel's v. Rahtjen's (supra).

In the absence of any confusion as to the source of manufacture or any acts which result in passing off of the defendant's product as plaintiff's, there can be no unfair competition under such cases as:

Delaware & H. Canal Co. v. Clark (supra); Saxlehner v. Wagner, 216 U. S. 375.

The decision also conflicts with the settled law that defendant may lawfully enter the competitive field at any time after the expiration of plaintiff's patents. A dedication once made cannot be recalled.

Centaur Co. v. Heinsfurter (C. C. A. 8), supra.

And the "right to individual appropriation once lost is gone forever."

Saxlehner v. Eisner, supra.

Finally, we confidently rely on the judgment of this Court in *William Warner v. Eli Lilly, supra.*

There the defendant was grossly unfair but this Court did not regard that as any ground for giving the plaintiff a perpetual monopoly of the right to combine cocoa and quinine as a remedy.

Here the defendant, Kellogg Company, was found to be scrupulously fair, yet plaintiff is given a perpetual monopoly of the form or shape and verbal and pictorial description of a patent-expired product.

Respectfully,

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EDWARD S. ROGERS,
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Counsel for Defendant-Petitioner.

APPENDIX.

As to Plaintiff's use of Shredded Wheat as a descriptive term.

Paragraph III, page 23, of Plaintiff's Brief on Rehearing below started with the caption "The name 'Shredded Wheat' when first adopted by the plaintiff, was not, and never has been merely descriptive of the product (not in record).

The argument was that the word "shredded" is only properly applicable to a substance that is cut or torn into small strips and that shreds that are made by rolling or mangling as distinguished from tearing are not shreds but are something else. As a matter of English, this is not so.

I. Dictionary use.

* Webster's New International Dictionary (Second Edition):

shred n. 1. A long, narrow piece cut or torn off; a strip; as, a *shred* of ground, of toast. 2. a A fiber-like strip, as of cloth, peel, thread, membrane, or cloud. b In general, a fragment; a piece; particle. 3. *obs.* a *pl* parings b A twig, c *slang* A tailor. 4. A shard *rare*.

shred v. 1. to cut; hew; lop off; prune; strip. *obs.* 2. To cut or tear into small pieces, esp. narrow and long pieces, as of cloth or leather; to tear into shreds. 3. To divide into two; to sever, as with shears.

scrod, scrotum, scroll, screed and shroud are all cognate words.

In the Oxford Dictionary (1914), the following occurs:

shredded wheat: The grain of wheat cut by machinery into long filaments. (Emphasis ours.)

The Century Dictionary (1910) has:

Shredder. h. 1. A machine for cutting into shreds or short slivers, the stalks, leaves, and husks of ripe corn plants in making stover or shredded fodder for

cattle . . . the machine delivers the shredded product to a stacker or to a baling press. 2. A machine for shredding whole wheat into long filaments or shreds. It consists essentially of pairs of steel rolls, one having a finely fluted face, placed above a traveling conveyor. Prepared whole wheat is fed between each pair of rolls and is torn into long threads, that fall upon the conveyor and are conveyed to cutting knives which divide them into cakes ready for baking." (Emphasis ours.)

II. Trademark and patent usage of shredded what was purely descriptive.

Moreover, the use of the words "shred" and "shredded" by plaintiff and its predecessors contradicts their counsel's assertion. For over forty years they have used the words "shred" and "shredded" to describe the product in their patents, now expired, under which the article was made, on the cartons containing it, and in the advertisements to the public, always in a merely descriptive sense.

To save the court the labor of referring to the voluminous exhibits, we quote the following (emphasis in each instance ours):

Trade-mark registration No. 85,186, January 30, 1912,

"no claim being made to the representation of a shredded-wheat biscuit . . ." The biscuit is shown in the drawing and is thus identified as shredded-wheat.

Trade-mark registration No. 89,071, November 5, 1912,

"has adopted and used the trade-mark . . . for shredded-wheat . . ."

Perky Patent No. 520,496, May 29, 1894, for a machine for the manufacture of food products from cereals,

"the resulting product . . . in the form of films, strings, or shreds are deposited . . ."

"these shreds, strings or films fall upon this roll . . ."

"which catches such shreds, strings or films . . ."

Perky Patent No. 521,810, June 26, 1894, for a machine for the manufacture of food products from cereals,

"in uniformly irregular shapes of shredded or filamentous form * * *."

Perky Patent No. 532,286, January 8, 1895,

"to receive the shredded or thread-like product
* * *."

Perky Patent No. 532,480, January 15, 1895, for a roll-machine for reducing cereals for food,

"to the form of long threads or shreds * * *."

"which disposes said threads or shreds lengthwise
* * *."

"discharged in thread or shred-like form * * *."

"these shreds or threads * * *."

"to receive the shreds or threads * * *."

"disposes these continuous shreds * * *."

"disposition of the shreds or threads * * *."

Perky Patent No. 532,481, January 15, 1895, for a perforated-roll machine for reducing cereals for food,

"for reducing grain to thread-like or shred-like form
* * *."

"in the form of threads or shreds * * *."

Ferky Patent No. 532,697, January 15, 1895, for a roll-machine for reducing cereals for food,

"for the reduction of grain to shredded or thread-like form * * *."

"the threads or shreds of the food product * * *."

"the grain or other material to be shredded * * *."

"the material to be shredded * * *."

"to receive the shredded or filamentous discharge
* * *."

Perky Patent No. 532,698, January 15, 1895, for a groove-roll machine for reducing cereals for food,

"for reducing grain or other articles for food to shredded or thread-like form * * *."

"discharged from these grooves in shred or thread-like form * * *"

Perky Patent No. 533,551, February 5, 1895, for a roll-machine for reducing cereals for food,

"to reduce the material to shred-like or filamentous form * * *."

"discharging the same in thread-like or shred form * * *."

Perky Patent No. 533,552, February 5, 1895, for a roll-machine for reducing cereals for food,

"for the reduction of grain to shredded or thread-like form * * *."

"the threads of material * * * in shredded or thread-like form * * *"

Perky Patent No. 533,553, February 5, 1895, for a roll-machine for reducing cereals for food,

"circumferentially grooved shredding roller * * *."

"to thread-like or shredded form, the threads or shreds being discharged therefrom * * *."

Perky Patent No. 533,554, February 5, 1895, for a roll-machine for preparation of cereals for food,

"in the shape of continuous fine threads or shreds * * *."

"discharged the threads or shreds of food * * *."

Perky Patent No. 533,555, February 5, 1895,

"one of the shredders in section * * *."

"a series of reducers or shredders * * *."

- "Each reducer or shredding device * * *."
- "in the form of continuous threads or shreds * * *."
- "the discharged threads or shreds * * *."
- "adherence of the shredded or threaded product * * *."
- "the threads or shreds of material * * *."

Perky Patent No. 548,086, October 15, 1895, for bread and method of preparing same,

- "their rough and porous thread-like or shred-like form * * *."

Perky Patent No. 571-284, November 10, 1896, for machine for reducing and preparing cereals for food,

- "to thread-like or shredded form * * *."
- "a series of reducers or shredding-heads * * *."
- "reduced by their grooved rollers to shred or thread-like form * * *."
- "a layer of the shred-like product * * *."
- "a series of reducing or shredding heads * * *."
- "the series of reducing or shredding heads * * *."
- "in a grain shredding or reducing machine * * *."
- "a grain shredding or reducing machine * * *."
- "in a grain reducing or shredding machine * * *."

Perky Patent No. 571,285, November 10, 1896, for machine for reducing cereals,

- "a small quantity of the shredded or filamentous product * * *,"

Perky Patent No. 598,745, February 8, 1898, for roll reducing-machine for preparing food,

- "the prepared grain above referred to or shreds of the same * * *."
- "the discharge of the shreds or strips * * *."

Perky Patent No. 614,338, November 15, 1898, for machine for reducing cereal food products to form for use,

- “several sets or gangs of **shredding** devices * * *.”
- “the number of **shredding**-heads in each set * * *.”
- “these roll-shredders discharge the material in the form of threads or **shreds** * * *.”
- “the threads or **shreds** are transferred * * *.”
- “the **shredding** or reducing head * * *.”
- “a comminuting or **shredding** effect * * *.”

Perky Patent No. 618,288, January 24, 1899, for apparatus for making folded wafers,

- “the reducing or **shredding** rolls * * *.”
- “the **shreds** or threads of the material * * *.”
- “to shredded form, the **shreds** or threads being discharged * * *.”
- “the threads or **shreds** are transferred * * *.”

Perky Patent No. 625,696, May 23, 1899, for a machine for reducing and baking cereals in form,

- “continuous layers of **shred** or thread-like form * * *.”
- “continuous threads or **shreds** * * *.”

Perky Patent No. 667,892, February 12, 1901, for apparatus for manufacturing cereals into forms of food or bread,

- “to shred or thread-like form, each head depositing a layer of the **shred**-like threads * * *.”

Perky Patent No. 678,127, July 9, 1901, for machine for reducing food material to form and distributing same,

- “reduced to **shred** or thread-like form * * *.”

Perky Patent No. 678,625, July 16, 1901, for pneumatic panning or distributing machine,

"formed by shredding the grain * * *."

Perky Patent No. 681,656, August 27, 1901, for continuous cutting-machine,

"machines for cutting shredded wheat * * *."

Burbank Patent No. 684,789, October 22, 1901, for distributive depositing or panning machine,

"sections or cakes of shredded wheat * * *."

Perky Patent No. 713,795, November 18, 1902, for filamentous cracker,

"a cracker of filamentous or shredded wheat or other grain * * *."

Perky Patent No. 797,604, August 22, 1905, for machine for preparing food,

"the fibered, filamentous, or shredded form of the reduced grain * * *."

"which shred the grain * * *."

III. Plaintiff's cartons, pamphlets and advertisements use the words "shred", "shredded", "shredded wheat", in a merely descriptive sense.

Plaintiff's carton (Exhibit D228, R. 1157) reads:

"The Original Shredded Wheat. It's all in the Shreds. Shredded Wheat is made of the whole wheat and is made digestible by steam-cooking, shredding and baking, contains all of the elements necessary for building, nourishing and sustaining the human body."

Plaintiff's pamphlet (Exhibit D229, R. 1157) reads in part:

"How shall we prepare the whole wheat so that its body-building elements may be digested and formed into healthy tissue, bone and brain? That question was solved by the man who invented Shredded Whole Wheat Biscuit. In making Shredded Wheat the whole wheat grains are first thoroughly cleaned, then cooked in steam, then drawn out into filmy shreds, then baked in ovens at a high temperature. The crispness of the shreds encourage thorough chewing, and that insures perfect digestion. That's the reason Shredded Wheat is such a perfect food for children. It makes sound teeth and healthy gums. They like the crisp, flavor shreds of the baked whole wheat, and it is so much better for them than mushy porridges."

Plaintiff's book of recipes (Exhibit D230, R. 1157) reads:

"Only plump whole grains of choice, sun-ripened wheat go into Shredded Wheat. Nothing added, nothing taken away. All the bran, the minerals, the vitamins Nature stores in this perfect cereal food are retained in Shredded Wheat.

Shredded Wheat brings you wheat in its most digestible form. The plump whole grains are steamed to break down all the starch cells, insuring quick digestibility. Then they are drawn into long, filmy shreds, so porous they will readily absorb more than four times their own weight in milk. Layer upon layer, the shreds form biscuits. Then—unsalted, unsweetened—they march into the ovens. And these tempting shreds of whole wheat are baked to a crisp and appetizing golden-brown."

Plaintiff wrote (Exhibit D227, R. 1157):

"We invite you to visit The Home of Shredded Wheat, either at Niagara Falls, or at Oakland, Calif. Your trip through the bright, clean bakeries will be an interesting experience, and competent guides will show you how the plump, sun-ripened whole wheat

grain is steam-cooked, drawn into filmy, porous shreds and baked into crisp, nutritious Shredded Whole Wheat Biscuit. Bring your friends with you! A treat is in store for you."

Plaintiff's advertisement (Exhibit D226, R. 1156) appearing at R. 1173-74, reads:

"YOU MUSTN'T GROW OLD.

Nature never intended us to grow old. Keeping the arteries soft and pliant is a matter of intelligent food selection and rational exercise. Avoid hardening of the arteries and the self-poisoning that comes from undigested foods by eating

SHREDDED WHEAT

By our **shredding** process we have developed a food that is thoroughly and completely digested in the stomach and intestines, supplying all the lime-salts that make good teeth, also bran for keeping the colon clean and healthy. Youngsters like the tasty crispness and the nutlike flavor of the baked wheat. Nothing better for them to grow on or play on—a salt-free food—you season it to suit your own taste.

When you ask for Shredded Wheat be sure you get the **original Shredded Wheat** you have always eaten, made at Niagara Falls, N. Y. It has taken twenty-five years to perfect and develop this clean, wholesome, nutritious whole wheat food. Made in a form and size that is most convenient whether eaten as a simple 'breakfast cereal' or in combination with fruits or creamed vegetables. Imitations are never as good as the original.

If you ask for Shredded Wheat and receive a different **Shredded Wheat** from that which you have always eaten (made in Niagara Falls, N. Y.), kindly write us at the Home Office and receive a copy of our booklet, 'The Happy Way to Health.'

Made for twenty-five years by

"THE SHREDDED WHEAT COMPANY,

NIAGARA FALLS, N. Y."

Plaintiff's advertisement (R. 1155) reads:

"Made at Niagara Falls. Look for the picture of Niagara Falls on the end of the carton when you buy Shredded Wheat Biscuit. Any other shredded wheat that may be offered you is merely a poor imitation of the only original Shredded Wheat, the kind your customers have always bought, the kind that stands up in the market, always clean, always pure, always the same. Made only at Niagara Falls, New York, in the cleanest, finest food factory in the world."

The following are excerpts from some of plaintiff's advertisements in evidence:

"All body-building material in the whole wheat steam-cooked, shredded and baked in the finest, cleanest food factory in the world."

Shredded wheat is

"—just whole grains of wheat steam cooked, shredded and baked to a crisp, golden brown, * * *."

"It is the whole wheat and nothing but the wheat, steam-cooked, shredded and baked in the cleanest, finest food factory in the world."

"Triscuit is the shredded wheat wafer * * *."

"* * * whole wheat grain, steam-cooked, shredded and baked."

"It is the shredding process that puts the 'eat' in whole wheat."

"The crisp, flavorful shreds of oven-baked whole wheat * * *."

"Have you tasted our new Triscuit? * * * It is the whole wheat steam-cooked, shredded, pressed into a wafer and baked in electric ovens."

"It's all in the Shreds."

"It is through the cooking and shredding process used in making Shredded Wheat that the whole wheat is prepared in its most digestible form."

" * * * the whole wheat made digestible by steam-cooking, shredding and baking."

" * * * the outer bran coat is scattered along the shreds in infinitesimal particles * * *"

"In making Shredded Wheat we make all these elements digestible by steam-cooking, shredding and baking into crisp, golden brown biscuits or 'little loaves'."

"In making Shredded Wheat Biscuit we steam-cook the grains of whole wheat, draw them into delicate, filmy shreds, form them into little loaves or Biscuits and bake them to a crisp, golden brown."

" * * * just pure wheat made digestible by steam-cooking, shredding and baking in crisp, golden brown Biscuits."

" * * * the whole wheat grains made digestible by steam-cooking, shredding and baking. The delicate, porous shreds of baked wheat * * * The shredding process compels into discard all broken, small and defective grains * * *"

"Try toasted Triscuit, the shredded wheat wafer, for luncheon * * *"

"Contains all the body-building elements of the whole wheat grain, steam-cooked, shredded and baked in convenient little loaves."

"Triscuit * * * is made of perfect whole grains of wheat cooked in steam, shredded, compressed into wafer form and baked in electric ovens."

"Shredded wheat is the whole wheat grain—steam-cooked, shredded and baked in convenient little loaves."

"Steam-cooked grains of whole wheat, shredded and baked in handy loaves * * *"

"Every biscuit is filled with the wholesomeness of whole wheat—made easy to serve and easy to eat in crisp, oven-baked shreds."

" * * * Crisp, flavorful shreds of whole wheat
* * * "

"All the goodness of the whole wheat grain made digestible by steam cooking, shredding and baking."

"It is the whole wheat steam-cooked, shredded and baked—nothing added, nothing taken away."

"Triscuit, the shredded wheat Toast."

Good Housekeeping, June, 1924:

" * * * Triscuit * * * is the whole wheat steam-cooked, shredded, pressed into a wafer and baked in electric ovens."

Ladies' Home Journal, March, 1927:

"Every shred gives golden health."

Good Housekeeping, November, 1928:

" * * * crisp, flavorful, oven baked shreds of whole wheat * * * "

Good Housekeeping, September, 1929:

"Those crispy shreds give teeth and glands their needed daily dozen."

Good Housekeeping, June, 1930:

" * * * flavorful shreds of baked whole wheat."

"You can't shred anything but perfect whole grains of cooked wheat. That's the reason we have to clean the wheat so thoroughly before shredding it. We then cook it and draw it into light, porous shreds * * * "

"Such a food is shredded whole wheat, made of the best white wheat that grows, cleaned, cooked, drawn into light porous shreds and baked."

"Every detail in the process of cleaning, cooking and shredding wheat is open to the world * * * "

The foregoing are typical examples of statements appearing throughout the mass of plaintiff's advertising. They could be multiplied indefinitely.

